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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/073,598

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Nicole Beaulieu

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07/22/2010

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

07/22/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@wavsip.com

Office Action Summary	Application No. 10/073,598	Applicant(s) BEAULIEU, NICOLE	
	Examiner ROBERT MOSSER	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Affidavit submitted under 37 CFR 1.131

The affidavit filed on July 23, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Joshi (USP 6,485,367) reference.

A. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Joshi (USP 6,485,367) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

I. The affidavit and attached evidence fails to demonstrate a correlation between the claimed invention, and the evidenced disclosure of the invention. The attached exhibits instead presents a general concept of employing a quick pick type feature as found in Keno in other type of selection environments and are silent to the exemplary feature of the utilization of game rules in making an automated selection according to the optimal strategy.

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. In re Tanczyn, 347 F.2d 830, 146 USPQ 298 (CCPA 1965). (MPEP 715.02)

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B. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Joshi (USP 6,485,367) reference to either a constructive reduction to practice or an actual reduction to practice.

I. From April of 2001 till November of 2001 there is no accounting for diligence. Specifically there exists a 7 month period during which the written description of the invention was forwarded to the applicant's representative and the applicant's representative presented the initial draft of the application that has not been accounted for. (MPEP 2138.06). The applicant must account for the relevant time at least from before the July 27, 2001 date of Joshi to the filing of the application.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. (MPEP 715.07(a))

II. The Affidavit submitted under 1.131 includes addition multiple lapses of continuity from the date of July 27, 2001 to the constructive reduction of practice and according fails to establish diligence (See element .B.I. above).

III. Work relied upon to demonstrate diligence must be directly related to the reduction to practice of the invention in issue (MPEP 2138.06). It is unclear how items 8, 12, and 13 directly relate to the constructive reduction of practice of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41, and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), and Bennett '178 teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008

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incorporated herein by reference however the Board decision is silent regarding the amended features directed *to the automated selection being made according to the rules of the game being played and according to a strategy to optimize the likelihood that said person will receive a value payout* and wherein responsive to a player request the automated selection system is programmed to make a selection from unselected game options after a person has executed a selection of the one or more options

The above referenced feature directed to the automated selection being made according to the rules of the game being played and according to a strategy to optimize the likelihood that said person will receive a value payout is however is taught by the reference of Joshi (Figure 7, Col 8:56-9:18) with particular reference to the identification of outcome probability and the indicated selection of elements with the greatest probability of a winning outcome. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the optimized auto-selection feature of Joshi into the combination of Bennett '102 , Appellant's Admitted Prior Art , and Bennett '178 in order to enable the player to select a default selection of the Applicant's admitted prior art without sacrificing optimal game actions.

The above referenced and newly claimed feature providing that responsive to a player request the automated selection system is programmed to make a selection from unselected game options after a person has executed a selection of the one or more options, provides the steps of the applicants admitted prior art (pages 1 and 2 of the applicant's specification) in combining automated selections with player selections. As best understood the applicant's proposed separation between the prior

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art and the claimed invention would rest on the order of execution and in particular that the player selection precedes the step of automated selection rather than follows it. The mere re-ordering of known method steps however is prima facie obvious (see MPEP 2144.04.IV.C). It would have been obvious to one of ordinary skill in the art at the time of invention to have included a player selection of game elements prior to an automated selection of elements in order to allow participants to fill in their favorite or lucky selections and allow the gaming device to populate the rest of the matrix thereafter and therewith adding an element of convenience in the selection process through ensuring the players' favorite or lucky selection are included without enduring the burden of inspecting and reselecting previously automated selections to ensure the inclusion of favorite or lucky numbers.

Claims **4**, **15**, **36**, and **44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Mayeroff, and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Mayeroff teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference.

Claims **10-11**, and **21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Walker and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Walker teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference.

Response to Arguments

Applicant's arguments filed March 22nd, 2010 have been fully considered but they are not persuasive.

Commencing on page 10, the applicant challenges the combination of prior art for allegedly not demonstrating the automated selection of one or more selectable options after a person has selected one or more options.

As set forth in the rejection of record and the board of appeal decision dated March 10th, 2008, the combination of prior art teaches the automated machine selection of player selectable game options and the incorporation of the subsequent player selection of selectable game options associated therewith. As presented in the rejection of claims as presented above, it would have been obvious to one of ordinary skill in the art at the time of invention to have re-ordered the known element steps of player selection of one or more player selectable selections and the machine selection steps of selecting one or more player selectable selections yielding the machine

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selection step after the player selection step, and in such provide the ability for the player to make the selections important to the player without the burden of making game selections that are not important to the player without the duplication of selections.

The applicant's challenge of pages 11 and 12 alleges that the steps are not taught by the prior art premised on the assertion that the order of the steps must be considered substantively incorporated into the steps themselves. The applicant alleges that claim language specifying the step of incorporating automated selection is made responsive to a player request *after* a player has made one or more selections is language that would modify the particular operation of the step rather than merely describing the order in which the step is executed. The applicant's argument on this point is however respectfully non-persuasive because that applicant' has not demonstrated beyond mere allegation that the inclusion of claim language specifying the order of steps would modify the particular operation of the step rather than merely describing the order in which the step is executed. Wherein the particular order of executed steps would have been obvious to one of ordinary skill at the time of claimed invention as set forth by MPEP 2144.04.IV.C as incorporated into the rejections as presented above.

Continuing on page 12 the applicant argues that even if the steps are provided for by the combination, the re-ordering of steps would allegedly not be obvious because the particular order of steps would provide an unexpected result. In particular the applicant alleges that if the automated selection step was performed prior to the player

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selection step then there would be no remaining unselected selections available for the player selection because the automated selection would make all of the selections.

This argument however proposes that though the properties of the steps were known at the time of invention, and specifically that the player selection can select fewer than all of the available selections and that the automated selection may complete the number of required selections, that the rearrangement of these known steps would have produced an allegedly unexpected result. The applicant's arguments, while identifying a proposed difference in the intermediate process associated with the re-ordering of steps, fails to demonstrate that the alleged unexpected result is unexpected, unobvious and is of both statistical and practical significance. In particular, the original arrangement of the prior art, the modified arrangement of the prior art, and the applicant's claimed arrangement, commonly transform an initial plurality of unselected selections into a final plurality of selected selections raising issue as to how the alleged unexpected result would be appreciable. Accordingly the applicant's proposition that the generation of an intermediate unexpected result is non-persuasive as the applicant has failed to establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance" (MPEP 716.02(b)).

Additional challenges based on the optimization of the automated selection have been addressed through the incorporation of the prior art of Joshi as previously applied while the re-ordering of steps as presented in the rejection as presented above enables the automated selection of game selections following the player selection of game selections to only effect the non-selected player selectable selections that would

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eliminate the duplication of work associated with reselecting/changing previously selected selections associated with the AAPA.

Applicant's remaining arguments are premised on those arguments redressed above and are accordingly considered redressed therewith.

Based on the above, the rejection of record is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

/R. M./
Examiner, Art Unit 3714